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PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

7 pages

Application Number

10/648,812 (Patent No. 6,903,106)

Filing Date

August 26, 2003

First Named Inventor

Scott E. Zook

Art Unit

1624

Examiner Name

Thomas C. McKenzie

Attorney Docket Number

690068.569

**ENCLOSURES (Check all that apply)**

Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)

Reply to Missing Parts/  
Incomplete ApplicationReply to Missing Parts  
under 37 CFR 1.52 or 1.53

Drawing(s)



Licensing-related Papers



Petition

Petition to Convert to a  
Provisional Application

Power of Attorney, Revocation



Change of Correspondence Address



Terminal Disclaimer



Request for Refund



CD, Number of CD(s) \_\_\_\_\_

☐ Landscape Table on CD

Remarks



After Allowance Communication to TC

Appeal Communication to Board  
of Appeals and InterferencesAppeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)

Proprietary Information



Status Letter

Other Enclosure(s) (please identify  
below):-Request for Reconsideration of Patent Term  
Adjustment-Copy of Decision on Application for Patent  
Term Adjustment dated March 30, 2005

-Return Postcard

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name

Neurocrine Biosciences, Inc.

Signature

Printed name

Richard H. Pagliery

Date

June 23, 2005

Reg. No.

44,276

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Typed or printed name

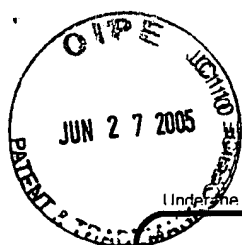
Megumi Novak

Date

June 23, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PTO/SB/17 (12-04v2)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

# FEE TRANSMITTAL

## For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 200.00

**Complete if Known**

Application Number	10/648,812 (Patent No. 6,903,106)
Filing Date	August 26, 2003
First Named Inventor	Scott E. Zook
Examiner Name	Thomas C. McKenzie
Art Unit	1624
Attorney Docket No.	690068.569

**METHOD OF PAYMENT (check all that apply)**☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_☒ Deposit Account Deposit Account Number: 503279 Deposit Account Name: Neurocrine Biosciences, Inc.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES****Fee Description**

Each claim over 20 (including Reissues)

Fee (\$)	Small Entity Fee (\$)
50	25

Each independent claim over 3 (including Reissues)

200	100
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Multiple dependent claims

360	180
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Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
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- 20 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
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- 3 or HP = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
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- 100 = \_\_\_\_\_ / 50 = \_\_\_\_\_ (round up to a whole number) x \_\_\_\_\_ = \_\_\_\_\_

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Fees Paid (\$)

Other (e.g., late filing surcharge): Filing an application for patent term adjustment per 37 CFR 1.18(e) \$200.00**SUBMITTED BY**

Signature	<u>Richard H. Pagliery</u>	Registration No. (Attorney/Agent) 44,276	Telephone 858-617-7280
Name (Print/Type)	Richard H. Pagliery		Date June 23, 2005

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentees : Scott E. Zook et al.  
Patent No. : 6,903,106  
Issued : June 7, 2005  
For : NOVEL POLYMORPH OF N-METHYL-N-(3-{3-[2-THIENYLCARBONYL]-  
PYRAZOL-[1,5- $\alpha$ ]-PYRIMIDIN-7-YL}PHENYL)ACETAMIDE AND  
COMPOSITIONS AND METHODS RELATED THERETO

Examiner : Thomas C. McKenzie  
Art Unit : 1624  
Application Serial No. : 10/648,812  
Docket No. : 690068.569  
Date : June 23, 2005

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Commissioner for Patents:

Patentees hereby request reconsideration of the patent term adjustment granted under 35 U.S.C. 154(b) as noted on the face of the patent.

Statement of the Facts:

The Determination of Patent Adjustment under 35 U.S.C. 154(b) on the face of the patent indicates that the Patent Term Adjustment for this patent is twelve (12) days. Patentees submit that the correct patent term adjustment for this patent should be fifty-five (55) days, calculated as follows:

- This application was filed on August 26, 2003.
- The initial action by the USPTO was a Notice of Allowance mailed

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October 28, 2004. Pursuant to 37 CFR 1.702(a), this initial action should have been issued by the USPTO within 14 months of the filing date of the application. Therefore, pursuant to 37 CFR 1.703(a)(1), the initial action was two (2) days late. The USPTO agreed with this determination, as evidenced by the Decision on Application for Patent Term Adjustment dated March 30, 2005.

- Patentees paid the issue fee on December 15, 2004, within three months of the mailing date of the Notice of Allowance.

- The patent issued on June 7, 2005.

- Pursuant to 37 CFR 1.703(6), the period of adjustment of patent term due to examination delay includes the number of days beginning on the day after the date that is four months after the date the issue fee was paid and ending on the date the patent was issued. Therefore, pursuant to 37 CFR 1.703(6), the patent term adjustment includes the period from April 16, 2005 to June 7, 2005, or fifty-three (53) days.

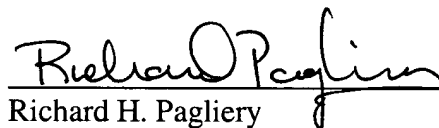
- There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 CFR 1.704. The USPTO agreed with this determination as well, as evidenced by the Decision on Application for Patent Term Adjustment dated March 30, 2005.

In view of the foregoing, Patentees are entitled to a patent term adjustment of fifty-five (55) days. Accordingly, Patentees respectfully request reconsideration of the patent term adjustment indicated on the face of the patent. Patentees note that this patent is not subject to a terminal disclaimer.

Patent No. 6,903,106  
Application Serial No. 10/648,812

The Director is authorized to charge the \$200 fee set forth in 37 CFR 1.18(e) as required under 37 CFR 1.705(b), and any additional fees due by way of this request, or credit any overpayment, to our Deposit Account No. 50-3279.

Respectfully submitted,  
Neurocrine Biosciences, Inc.

A handwritten signature in black ink, appearing to read "Richard H. Pagliery", written over a horizontal line.

Richard H. Pagliery  
Registration No. 44,276

Enclosures:

Copy of Decision on Application for Patent Term Adjustment dated March 30, 2005

12790 El Camino Real  
San Diego, CA 92130  
Phone: (858) 617-7280  
Fax: (858) 777-3488



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SUITE 6300  
SEATTLE, WA 98104-7092

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**MAR 30 2005**

**OFFICE OF PETITIONS**

In re Application of	:	
Zook et al.	:	
Application No. 10/648,812	:	DECISION ON APPLICATION
Filed: August 26, 2003	:	FOR
Atty Docket No. 690068.569	:	PATENT TERM ADJUSTMENT
	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT" filed December 15, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) to two (2) days.

The application for patent term adjustment is GRANTED.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is two (2) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On October 28, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. The period of adjustment of 2 days for Office delay was reduced by 21 days for applicant delay. On December 15, 2004, applicants timely<sup>1</sup> submitted an

<sup>1</sup> PALM records indicate that the Issue Fee was also received in the Office on December 15, 2004.

application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is 2 days. Applicants dispute the reduction of 21 days attributed to delay in responding to the Notice to File Missing Parts of Application mailed November 18, 2003. Applicants state that their response was received in the Office on January 16, 2004, and thus, there was no applicant delay.

Applicants further state that the patent issuing from the application is not subject to a terminal disclaimer.

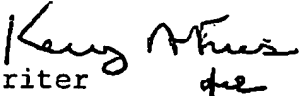
Applicants are correct. Their response to the Notice to File Missing Parts of Application mailed November 18, 2003, is of record in the application with a date of receipt by the Office of January 16, 2004. Furthermore, the response included a complete reply to the Notice. Thus, the Office should not have assessed applicant a delay of 21 days. The response was filed within the three-month period under 37 CFR 1.704(b). Applicants did not fail to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts of Application.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is TWO (2) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office will forward the file to the Office of Patent Publication so that a patent can be issued.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

  
Karin Ferriter  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen